

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 32758US6									
<div style="font-family: monospace; font-size: small; border: 1px solid black; padding: 2px; margin-bottom: 5px;">I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 (37 CFR 1.54)</div> <div>xx electronically on 01-16-2007</div> <div>Signature <u>/Robert F. Bodi/</u></div> <div>Typed or printed name <u>Robert F. Bodi</u></div>		Application Number 10/662,707	Filed 09/15/2003								
		First Named Inventor Masaki Terashima									
		Art Unit 3662	Examiner Ian J. Lobo								
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table style="width: 100%; border: none;"><tr><td style="width: 50%; vertical-align: top; padding: 5px;"><input type="checkbox"/> applicant/inventor.</td><td style="width: 50%; vertical-align: top; padding: 5px;"><u>/robertfbodi/</u> Signature</td></tr><tr><td style="vertical-align: top; padding: 5px;"><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td style="vertical-align: top; padding: 5px;"><u>Robert F. Bodi</u> Typed or printed name</td></tr><tr><td style="vertical-align: top; padding: 5px;"><input checked="" type="checkbox"/> attorney or agent of record. 48540 Registration number _____</td><td style="vertical-align: top; padding: 5px;"><u>216/579-1700</u> Telephone number</td></tr><tr><td style="vertical-align: top; padding: 5px;"><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td><td style="vertical-align: top; padding: 5px;"><u>January 16, 2007</u> Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>				<input type="checkbox"/> applicant/inventor.	<u>/robertfbodi/</u> Signature	<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	<u>Robert F. Bodi</u> Typed or printed name	<input checked="" type="checkbox"/> attorney or agent of record. 48540 Registration number _____	<u>216/579-1700</u> Telephone number	<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	<u>January 16, 2007</u> Date
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<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.											

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Masaki Terashima
Appln. No. : 10/662,707
Filed : September 15, 2003
Title : ROAD ANTENNA CONTROLLED ON THE BASIS OF
RECEIVING RATE

Conf. No. : 1017
TC/A.U. : 3662
Examiner : Ian J. Lobo

Customer No. : 000,116
Docket No. : 32758US6

Mail Stop Appeal
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ARGUMENTS/REMARKS

These remarks are provided along with a Notice of Appeal and a Request for a Pre-Appeal Brief Conference Review. Claims 15, 16, 27, and 28 remain in this application. Claims 1-14 and 17-26 have been previously canceled.

Claims 15, 16, 27 and 28 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. For the following reasons, the rejection is respectfully traversed.

The Examiner complains that claim 15 and claim 27 both recite “‘control means’ which ‘inhibits’ or ‘allows’, respectively, establishment of communication with the vehicle traveling in a predetermined direction.” Despite applicant amending the claims as suggested by the Examiner at the previously conducted personal interview, the Examiner maintains his rejections of these claims.

The Examiner argues that the specification and drawings do not provide an enabling disclosure of *how* the control section “‘inhibits’ or ‘allows’ such communications.” At the personal interview, applicant pointed out the teachings of the specification, and the Examiner requested that applicant point out where the specification

discusses such features in a formal response to the outstanding Office action, which the applicant did by noting that on page 46 of the specification, it is discussed that communications with a vehicle is “inhibited” depending on the direction of the vehicle. Furthermore, on pages 18-19 of the specification, it is discussed that communication is established with a vehicle traveling in the proper lane and/or direction, and that communication is inhibited if the vehicle is traveling in the improper lane and/or direction. Accordingly, the specification supports the language of the claim.

Nevertheless, the Examiner maintains that the specification does not disclose “HOW” the invention would inhibit or allow such communication. MPEP §2164.05 clearly states that enablement only requires disclosure sufficient to allow one “skilled in the art” to practice the invention. Applicant maintains that it is well within the skill in the art to practice such a feature, as the specific functions of inhibiting and establishing communications are generally known in the art. In particular, one skilled in the art could merely turn a transmitter/receiver on or off depending on whether the communication was allowed or inhibited (i.e., depending on the direction of travel). Thus, if communication is allowed (i.e., the vehicle is traveling in one direction), the apparatus could enable communication by allowing transmission to, and reception from, the vehicle. In contrast, if communication is not allowed (i.e., inhibited because the vehicle is traveling in another direction), the apparatus could just turn off the communications function. Furthermore, other implementations also exist, such as merely ignoring any incoming transmissions (by, for example, failing to respond or analyze a query signal) and refusing to transmit any return signals, or not transmitting a query if the vehicle expects such a query to establish communication. The mere function of establishing or inhibiting communication, standing alone, is not the novel aspect of the invention and is within the skill of the art. It is combining this feature with the additional claim limitations that provides the novelty of the invention, and makes the claims patentable over the prior art.

Accordingly, because practicing the feature of inhibiting communications is well within the means of one skilled in the art, there is no need to specifically recite “HOW” such a feature would be implemented in the specification. The Examiner’s demand for an explanation of “how” the device would inhibit or allow communications is like

requiring disclosure of how a signal might be “amplified” or “attenuated” in a transmitter. Such functions are well-known and are implemented in a variety of ways known to those skilled in the art, and thus specific implementations need not be explicitly explained for engineers skilled in the art to practice them. Similarly, the functions of “inhibiting” or “allowing” a communication to take place is also within the skills of such engineers. Accordingly, the Examiner should withdraw his rejection under 35 U.S.C. §112, first paragraph, and allow the claims because the claims are not rejected under any prior art.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 32758US6.

Respectfully submitted,
PEARNE & GORDON, LLP

By: _____ / Robert F. Bodi /
Robert F. Bodi, Reg. No. 48540

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Date: January 16, 2007